Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed February 4, 2009. Although Applicant believes all claims are allowable without amendment, to advance prosecution Applicant has amended independent Claims 1, 9, and 22. At least certain of these amendments are not considered narrowing, and none are considered necessary for patentability. Additionally, none of these amendments are made in relation to any reference cited by the Examiner. Applicant respectfully requests reconsideration and allowance of all pending claims.

I.   Summary of Examiner Interview

Applicant's attorney, Chad D. Terrell, conducted a telephone interview with Examiner Oyebisi on March 18, 2009. Pursuant to M.P.E.P. ch. 713.04, Applicant submits this summary of the telephone interview to record Applicant's understanding of the substance of the interview. If Applicant's understanding is inaccurate, notice of such is appreciated. Applicant's attorney thanks the Examiner for the courtesy of the interview. During the interview, the Examiner and Applicant's attorney discussed the Examiner's rejections under 35 U.S.C. §101, and the Examiner suggested various claim amendments to overcome the rejections of Claims 1-8 under 35 U.S.C. §101.

II.   Claims 1-8, 9-16, and 22-28 Recite Patentable Subject Matter

The Examiner rejects Claims 1-8, 9-16, and 22-28 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner rejects Claims 1-8 under 35 U.S.C. §101 for failing to be "sufficiently tied to another statutory class" and for failing to "sufficiently transform the underlying subject matter." *Final Office Action* at 2-3. Although Applicant believes Claims 1-8 recite patentable subject matter as written, to advance prosecution Applicant has made a clarifying amendment to independent Claim 1 such that Claim 1 recites "generating, *using one or more computers*, an image replacement document representative of the check . . . ." Applicant believes that, in light of the Examiner's comments in the Examiner Interview and statements in the *Final Office Action*, these amendments place the Application in better condition for

allowance and/or reduce issues for Appeal. Therefore, Applicant respectfully requests that the Examiner enter these amendments.

The Examiner rejects Claims 9-16, and 22-28 under 35 U.S.C. §101 as being directed to non-statutory descriptive material because the claims recite logic "not claimed as encoded on computer-readable media." *Final Office Action* at 3. Although Applicant believes Claims 9-16, and 22-28 recite patentable subject matter as written, to advance prosecution Applicant has made clarifying amendments to independent Claims 9 and 22, such that the claims recite "Logic *encoded in computer-readable storage media* for effecting payment by a check . . . ." Applicant believes that, in light of the Examiner's statements in the *Final Office Action*, these amendments place the Application in better condition for allowance and/or reduce issues for Appeal. Therefore, Applicant respectfully requests that the Examiner enter these amendments.

For at least these reasons, Applicant respectfully submits that independent Claims 1, 9, and 22 and their respective dependent claims are directed to patentable subject matter and requests reconsideration and allowance of Claims 1-8, 9-16, and 22-28.

III.   Claims 1-16 Comply with 35 U.S.C. § 112

The Examiner rejects Claims 1-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses these rejections and discusses independent Claim 1 as an example.

In particular, the Examiner rejects Claim 1 based on the limitation "determining the checking account of the particular account holder based on the payment information from the purchase transaction." The Examiner states, "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." *Final Office Action* at 4.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 U.S.P.Q.2d 1429, 1438 (Fed. Cir. 2003); M.P.E.P. ch. 2163(I). The Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. M.P.E.P. ch. 2163.III(A). *"The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the written description requirement."* M.P.E.P. ch. 2163.02 (emphasis added). To comply with the written description requirement, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. M.P.E.P. ch. 2163(II)(A)(3)(b). In addressing the Examiner's rejection, Applicant refers to example discussions within the Specification; however, reference to these portions should not be used to limit Applicant's claims.[1]

Non-limiting support for the limitations of Claim 1 referenced by the Examiner can be found at least in Figure 6 and at page 4, lines 2-14; page 12, line 14 - page 13, line 6; and page 13, line 22 - page 14, line 8 of Applicant's Specification. While the particular phrasing used in the claim may not appear explicitly in the Specification, it is at least implicit, and one of ordinary skill in the art would appreciate, that the Specification discloses "determining the checking account of the particular account holder based on the payment information from the purchase transaction," as recited in Claim 1.

As just one non-limiting example, Page 12 of the Specification states that "services company 116 includes image template database 122. Image template database 122 stores a plurality of image templates corresponding to the checking accounts of account holders, such as consumer 102." Page 12 of the Specification also states that "once payment information for a particular transaction is completed by consumer 102, then a snippet may be taken of the filled in information . . . and thereafter transferred to services company 116 via

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[1] *See Superguide Corp. v. DirecTV Enters., Inc.*, 2004 WL 253013, at *3 (Fed. Cir. 2004) (stating that the specification of a patent cannot be used to import limitations into a claim that are not recited in the claim to narrow or otherwise change the ordinary meaning of a claim term).

communications network 124. Pages 12-13 of the Specification further state that "IRD tool 120 may then . . . retrieve from image database 122 the *pertinent image template corresponding to the checking account of consumer 102* and merge the image template with the snippet received in order to create image replacement document 500."

In response to these arguments, the Examiner states that "no where in these figures and pages did the examiner find the claimed limitation 'determining the checking account of the particular account holder based on the payment information from the purchase transaction.' Thus, the examiner maintains the rejection of claims 1-16 under 35 U.S.C. 112, first paragraph." *Final Office Action* at 20-21. Applicant reiterates that, for the reasons discussed above, the particular phrasing used in the claim is at least implicit in the Specification, and one of ordinary skill in the art would appreciate that the Specification discloses "determining the checking account of the particular account holder based on the payment information from the purchase transaction," as recited in Claim 1.

For at least these reasons, Applicant respectfully submits that Claim 1 complies with 35 U.S.C. § 112, first paragraph, and requests reconsideration and allowance of Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully submits that independent Claim 9 complies with 35 U.S.C. § 112, first paragraph, and requests reconsideration and allowance of Claim 9 and its dependent claims.

IV.   The Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

The Examiner rejects Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application 2004/004606 by Buttridge et al. (*"Buttridge"*) in view of U.S. Patent 6,978,046 to Robinson et al. (*"Robinson"*). Applicant respectfully traverses these rejections and discusses independent Claims 1, 17, and 29 as examples.

A.   Independent Claims 1 and 9 and Their Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

1.   The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest "in response to receiving the payment information . . . determining the checking account of the particular account holder."

As allegedly disclosing these limitations, the Examiner relies on allegedly inherent aspects of *Buttridge*, stating that:

> Buttridge discloses at the point of sale receiving a transaction amount and the checking account information, see paras 0011. Inherently, Buttridge can use the received checking account information to determine the checking account of the particular account holder based on the payment information for from the purchase transaction.

Final Office Action at 5-6. Even assuming for the sake of argument only and not by way of concession that *Buttridge* discloses "electronically receiving payment information for a check for a purchase transaction" as recited in Claim 1, Applicant respectfully submits that the Examiner has still failed to establish that the above recited limitation of Claim 1 is inherent in *Buttridge*.

The Examiner bears the initial burden of proof to establish inherency. *See* M.P.E.P. ch. 2112. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons or ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may result* from a given set of circumstances is not sufficient." MPEP ch. 2112.IV (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." M.P.E.P. ch. 2112 (emphasis in original).

Applicant respectfully submits that the Examiner, although relying upon the theory of inherency, has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics <u>necessarily</u> flows from the teachings of the *Buttridge*, which is required to support a case of inherency. Furthermore, Applicant asserts that the there is no basis in fact or technical reasoning that could be asserted by the Examiner to support the determination that "determining the checking account of an account holder," as recited in Claim 1, <u>necessarily</u> flows from "electronically receiving

payment information," as allegedly disclosed in Buttridge.[2] Therefore, *Buttridge* does not disclose, teach, or suggest, either expressly or inherently, "in response to receiving the payment information . . . determining the checking account of the particular account holder," as recited in Claim 1.

In response to these arguments, the Examiner merely reiterates the above-discussed position, stating that "[i]nherently, Buttridge can use the received checking account information to determine the checking account of the particular account holder based on the payment information for from the purchase transaction." *Final Office Action* at 21. For the reasons discussed above, Applicant maintains that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics <u>necessarily</u> flows from the teachings of the *Buttridge*.

The cited portions of *Robinson* do not appear to account for these deficiencies of *Buttridge*, and the Examiner does not make any assertions to the contrary.

> 2. The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest "in response to receiving the payment information . . . retrieving . . . an image replacement document template associated with the checking account of the particular account holder."

The Examiner, having acknowledged that *Buttridge* does not explicitly disclose the above-recited limitation, states generally that "Robinson explicitly discloses an image replacement template." *Final Office Action* at 6. The Examiner cites column 2, lines 50-62 of *Robinson* as disclosing the above-recited limitation of Claim 1. *Id.* The cited portion of *Robinson* states:

> The systems and methods according to this invention allow the scan/preparation user generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document. According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template

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[2] Applicant assumes for the sake of argument only and not by way of concession that "electronically receiving payment information for a check for a purchase transaction" as recited in Claim 1, is disclosed in *Buttridge*.

for a page of the existing document. In various embodiments, the
template is created from a scanned input.

Robinson at 2:50-62.

The Examiner does not point to any particular portion of *Robinson* as specifically disclosing "in response to receiving the payment information . . . retrieving . . . an image replacement document template," as recited in Claim 1. Instead the Examiner states generally that an "image replacement document template" is disclosed in *Robinson*. *Final Office Action* at 6. Even assuming for the sake of argument only that *Buttridge* discloses "receiving payment information" as recited in Claim 1 and that *Robinson* discloses "retrieving an image replacement document template" as recited in Claim 1 (which Applicant does not concede), the proposed *Buttridge-Robinson* combination would still fail to disclose, teach, or suggest retrieving an image replacement document template *in response to receiving the payment information*, as recited in Claim 1.

Applicant respectfully submits that the Examiner appears to be selecting disjointed elements of the cited references and claiming that those disjointed elements can be combined such that Applicant's claim is rendered obvious. However, neither cited reference discloses, teaches, or suggests "in response to receiving the payment information . . . retrieving . . . an image replacement document template associated with the checking account of the particular account holder," as recited in Claim 1.

    3.   The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest "generating, using one or more computers, an image replacement document representative of the check."

The Examiner, having acknowledged that *Buttridge* does not explicitly disclose the above-recited limitation, cites column 2, lines 50-62 of *Robinson*, reproduced above, as disclosing the above-recited limitation of Claim 1 (prior to the current amendment, which, as Applicant noted above, is not related to the rejections based on the proposed *Buttridge-Robinson* combination). *Final Office Action* at 6. In addition, the Examiner states that the "Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image

replacement document representative of a check." *Id.* Despite the Examiner's assertion to the contrary, Applicant maintains that *Robinson* fails to disclose, teach, or suggest "generating an image replacement document representative *of the check*," as recited in Claim 1.

In response to these arguments, the Examiner cites column 3, lines 7-14 of *Robinson*. The cited portion of *Robinson* states the following:

> Once the attributes of the objects are identified, a template containing the attributes is synthesized. Once created, the template is saved in any desired template format for use with word processing software or the like. The template can then be used to create additional/replacement pages for the existing document that are visually coherent with the predetermined visual design theme of the document.

Final Office Action at 22 citing *Robinson* at 3:7-14. Furthermore, the Examiner states, "The Examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement document generator can generate an image replacement document representative of a check." *Final Office Action* at 22. The Examiner also states that "since date, payee name, a dollar amount, a legal amount, and a signature are all data elements/information on a document/check, and since Robinson can scan input document for the creation of document template, Robinson can certainly scan all data elements/information on a document/check . . for the creation of a document template." *Id.* The Examiner appears to be asserting that *Robinson* discloses the generation of an image replacement document template representative of a check. Even if the Examiner's apparent assertion is appropriate (which Applicant does not concede), the *generation of an image replacement document template* representative of a check does not disclose, teach, or suggest "generating, using one or more computers, *an image replacement document representative of the check*," as recited in Claim 1.

The cited portions of *Buttridge* do not appear to account for these deficiencies of *Robinson*, and the Examiner does not make any assertions to the contrary.

4.   The proposed *Buttridge-Robinson* combination in improper.

Applicant submits that the Examiner has not demonstrated a *prima facie* case of obviousness because the Examiner has not provided an adequate reason either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to combine or modify the references in the manner proposed by the Examiner.   As allegedly providing a reason for the proposed *Buttridge-Robinson* combination, the Examiner states the following:

> [I]t would have been obvious to one of ordinary skill in the art to combine the teachings of Buttridge and Robinson so that manual labor and human errors are reduced when users generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of a document.

Final Office Action at 7.

Applicant submits that the Examiner's statement for combining *Buttridge* with *Robinson* does not satisfy the stringent standards for establishing a *prima facie* case of obviousness. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Examiner simply has not presented any "articulated reasoning with some rational underpinning" that it would have been obvious to make the proposed combination.

Applicant notes that "[t]he factual inquiry whether to [modify] references must be thorough and searching." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Any "conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* The Examiner's identification of a perceived advantage of one of the references does not provide an adequate "factual inquiry." The Examiner gives no technical reasoning as to how these systems can be combined and, if combined, would be successfully combined. This conclusory assertion surely cannot be said to be "thorough and searching."

Applicant also notes that it is unclear why one of ordinary skill in the art would be motivated to combine the teachings of *Buttridge* and *Robinson* to reduce manual labor and human errors to generate an image replacement template representative of the original document, as asserted by the Examiner. Even assuming for the sake of argument only that *Robinson* discloses that its system generates an image replacement document template representative of any documents and that the replacement image document template generator can generate an image replacement document template representative of a check, as asserted by the Examiner, it is entirely unclear why supposedly reducing manual labor and human errors for users to generate additional and/or replacement pages for an existing document would lead one of ordinary skill in the art to combine these purported disclosures with the system of *Buttridge*, let alone how the combination would achieve these supposed advantages. The system in *Buttridge* scans a physical check at the point of sale and transfers the entire check's image data to a store controller. *See Buttridge* at ¶ 0011. *Robinson* provides automated creation of a template for a page of an existing document from a scanned input. *See Robinson* at 1:31-33. Applicant respectfully asks the Examiner: Where in the system of *Buttridge* would one of ordinary skill in the art of the time of Applicant's invention even incorporate the identified teaching of *Robinson*? Applicant also respectfully asks the Examiner: How would modifying *Buttridge* in such a way even achieve a reduction in manual labor and human error?

Thus, Applicant submits that the Examiner's attempt to combine *Buttridge* with *Robinson* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

5.   Conclusion

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 9 and its dependent claims.

B. **Independent Claims 17 and 22 and Their Dependent Claims are**
Allowable over the Proposed *Buttridge-Robinson* Combination

At a minimum, the cited portions of the proposed *Buttridge-Robinson* combination fail to disclose, teach, or suggest "electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet," as recited in Claim 17. As allegedly disclosing "generating a snippet of payment information," the Examiner cites paragraph 41 of *Buttridge*. *Final Office Action* at 14. The cited portion of *Buttridge* states:

> After the two outputs are transferred and stored in the data storage units, e.g., on the hard drive of the store controller and/or central controller, the store controller sends a completion message to the cash register indicating the end of the transaction, at 170. Alternatively, the cash register may send the transaction and image data to the store controller and the store controller then generates and forwards the required data to the batch data storage unit and to the authorization data storage unit.

Buttridge at ¶ 41. The Examiner acknowledges that "Buttridge does not explicitly disclose electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet." *Final Office Action* at 14. In responding to Applicant's previously presented arguments, however, the Examiner appears to suggest that *Buttridge* does in fact disclose at least "electronically transmitting the snippet to a remote location," as recited in Claim 17, because the Examiner states that "the authorization storage unit [recited in ¶ 41 of *Buttridge*] is a remote location and the required data that is generated and forwarded . . . is akin to the applicant's claimed snippet." *Final Office Action* at 24. The Examiner also cites to *Robinson* as allegedly disclosing "electronically transmitting the snippet to a remote location for generation of an image replacement document," again merely asserting that the "Robinson system generates an image replacement document representative of any documents." *Final Office Action* at 14.

Even assuming for the sake of argument only that *Buttridge* discloses "generating a snippet," as asserted by the Examiner, and that *Robinson* discloses the "generation of an image replacement document representative of the check," as asserted by the Examiner, the proposed *Buttridge-Robinson* combination would still fail to disclose, teach, or suggest

"electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check *based on the snippet*," as recited in Claim 17.

As stated above, Applicant respectfully submits that the Examiner appears to be selecting disjointed elements of the cited references and claiming that those disjointed elements can be combined such that Applicant's claim is rendered obvious. However, neither cited reference discloses, teaches, or suggests "electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet," as recited in Claim 17.

Furthermore, for reasons substantially similar to those discussed above with regard to independent Claims 1 and 9, Applicant submits that the Examiner's attempt to combine *Buttridge* with *Robinson* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 17 and its dependent claims. For at least certain analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 22 and its dependent claims.

C. Independent Claim 29 and its Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

At a minimum, the cited portions of the proposed *Buttridge-Robinson* combination fail to disclose, teach, or suggest the following limitation recited in Claim 29:

- in response to receiving the snippet, retrieving, from a storage location, an image replacement document template associated with the checking account; and
- generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template

As allegedly disclosing these limitations, the Examiner relies on *Robinson*. *Final Office Action* at 18-19. For reasons substantially similar to those discussed above with regard to independent Claim 1, 9, 17, and 22, Applicant maintains that *Robinson* does not disclose, teach, or suggest either "in response to receiving the snippet, retrieving, from a storage location, an image replacement document template associated with the checking account" or "generating an image replacement document representative of the check by inserting the payment information from the snippet," both of which are recited in Claim 29.

The cited portions of *Buttridge* do not appear to account for these deficiencies of *Robinson*, and the Examiner does not make any assertions to the contrary.

Furthermore, for reasons substantially similar to those discussed above with regard to independent Claims 1 and 9, Applicant submits that the Examiner's attempt to combine *Buttridge* with *Robinson* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 29 and its dependent claims.

V. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.
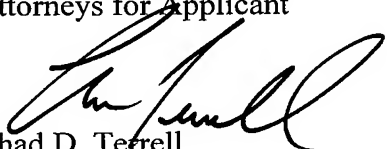
Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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Date: April 6, 2009

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